

Application No. 10/657,607

REMARKS

Claims 1-10, 12-31 and 33-36 are pending. By this Amendment, claims 1, 17, 26 and 35 are amended, and claims 11 and 32 are cancelled. The amendments to claims 1, 17, 26 and 35 are supported by the specification at, for example, Page 17, lines 11-24. No new matter is introduced by the present Amendment. Claims 1-36 currently stand as rejected, and Applicants respectfully request reconsideration of the rejections based upon the following remarks.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner asserted that "Applicants' use of de-ionized water is the only solvent used to dissolve the salts and the claims should be directed to this solvent." "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." See MPEP § 2163. Applicants submit that one of ordinary skill in the art would understand, after reading Applicants' specification, that the explicit reference to de-ionized water was exemplary and that any appropriate solvent could be used to form the claimed organophotoreceptors. As such, one of ordinary skill in the art would understand the present inventors had possession of the claimed invention. Since one of ordinary skill in the art would understand that the present inventors had possession of the claimed invention, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the description requirement.

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Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner noted a spelling error in line 8. Applicants thank the Examiner for a close reading of the claims. Applicants have inserted a space into line 8 to correct the spelling error, and submit that claim 26 is definite. Since claim 26 is definite, Applicants respectfully request the withdrawal of the rejection of claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-35 under 35 U.S.C. § 103(a) as being unpatentable over JP 01-276142 or GB 2052081 in view of U.S. Patent 6,066,425 to Ferrar et al. (the '425 patent). More specifically, the Examiner asserted that, "it would be obvious to one of ordinary skill in the art at the time of applicant's invention with a reasonable expectation of success to use the salts as charge carriers as the charge carriers salts as taught in either JP or GB to improve resistance to migration of the charge carrier. To advance prosecution of the application, Applicants have amended the independent claims to more particularly point out their claimed invention. In view of the amendments, Applicants submit that the Examiner has failed to establish a prima facie case of obviousness, and respectfully request reconsideration of the rejection based upon the following comments.

In order to establish a prima facie case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP § 2143. The JP reference relates to a photosensitive layer having lead salts compounds, while the GB reference discloses a protective layer having salts comprising a monovalent cation such as Ag^+ , K^+ and Na^+ . With respect to the '425 patent, the salts disclosed in that patent also comprise

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monovalent cations such as Li^+ , Na^+ , and K^+ . In contrast, Applicants invention, as claimed in independent claim 1, 16, 26 and 35, relates to an organophotoreceptor having an overcoat layer comprising a first binder and at least an inorganic ionic salt, wherein the inorganic ionic salt comprises a multivalent cation selected from the group consisting of Ca^{+2} , Mg^{+2} , Sr^{+2} , Ba^{+2} , Al^{+3} , Co^{+2} , Ni^{+2} , Cu^{+2} , and Zn^{+2} . Since neither the JP reference, the GB reference, nor the '425 patent disclose or suggest an overcoat layer comprising an inorganic ionic salt, wherein the inorganic ionic salt comprises a multivalent cation selected from the group consisting of Ca^{+2} , Mg^{+2} , Sr^{+2} , Ba^{+2} , Al^{+3} , Co^{+2} , Ni^{+2} , Cu^{+2} , and Zn^{+2} , the combination of either the JP reference or the GB reference with the '425 patent does not render Applicants' claimed invention prima facie obvious.

Since the combination of the either the JP reference or the GB reference and the '425 patent does not render Applicants invention, as claimed in independent claims 1, 17, 25 and 35, prima facie obvious, Applicants respectfully request the withdrawal of the rejections of claims 1-35 under 35 U.S.C. § 103(a) as being unpatentable over JP 01-276142 or GB 2052081 in view of the '425 patent.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 35 and 36 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent 5,693,442 (the '442 patent). More specifically, the Examiner asserted that the '442 patent "teaches a charge generating element with an overcoat layer. The overcoat layer can be other than the preferred silsesquioxanes note Col. 5 line 4-10. The salt can be a Li or Na charge carrier salt...." Applicants submit that the '442 patent does not prima facie anticipate

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Applicants' presently claimed invention, and respectfully request reconsideration of the rejection based on the following comments.

The '442 patent discloses salts in an overcoat layer that comprise monovalent cations such as Li^+ , Na^+ , K^+ , Rb^+ and Cs^+ . See column 10, line 50 to column 11, line 13. In contrast, Applicants' invention as presently claimed in independent claim 35 relates to photoreceptor having an overcoat layer comprising an inorganic ionic salt, wherein the inorganic ionic salt comprises a multivalent cation selected from the group consisting of Ca^{+2} , Mg^{+2} , Sr^{+2} , Ba^{+2} , Al^{+3} , Co^{+2} , Ni^{+2} , Cu^{+2} , and Zn^{+2} . Since the '442 patent does not disclose this feature of Applicants' claimed invention, the '442 patent does not *prima facie* anticipate Applicants' invention, as presently claimed in independent claim 35.

Since the '442 patent does not *prima facie* anticipate Applicants' invention, as claimed in independent claim 35, Applicants respectfully the withdrawal of the rejection of claims 35 and 36 under 35 U.S.C. § 102(a) as being anticipated by the '442 patent.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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